

REMARKS

Claims 1 and 3-56 are pending in this application. Claims 6-10 and 12-56 are withdrawn as being directed to a non-elected invention. There is an objection to the specification. There is also a rejection of claims 1, 3-5, and 11 under 35 U.S.C. § 112, second paragraph, for lack of clarity. Finally, claims 1, 3-5, and 11 are rejected under 35 U.S.C. § 103 for obviousness over Laurent et al. (U.S. Patent No. 4,847,085; hereinafter "Laurent") in view of Wadsworth et al. (U.S. Patent Application Publication No. 2002/0182276; hereinafter "Wadsworth"), Watson (U.S. Patent No. 6,228,367; hereinafter "Watson"), and Maurer et al. (EP Patent No. 1208849; hereinafter "Maurer"). By this reply, Applicants amend the specification and claims 1, 10-13, 20, 22-28, 34, and 45, cancel claims 18 and 19, and address each of the rejections.

Elected Invention

In the present Office Action, the Office states that Applicants elected claims 1, 3-5, and 11 without traverse in the Reply to Restriction Requirement filed on September 17, 2008. The Office states that "[c]laims 6-10 and 12-56 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to...nonelected inventions and species, there being no allowable generic or linking claim" (Office Action, p. 2). Applicants note that claims 12-17, which depend from pending claim 11, are not generic and should be examined with pending claims 1, 3-5, and 11. Applicants also request rejoinder of the withdrawn claims upon the allowance of a generic claim as provided by 37 C.F.R. § 1.141.

Support of the Amendment

Support for the amendment to claim 1 is found in prior claims 18 and 19 and in the abstract of the invention. Support for the amendment to claims 25 and 45 is found in the specification at, e.g., page 12, lines 3-9. Claims 10-13, 20, 22-24, 26-28, and 34 are amended to clarify the claimed subject matter. No new matter is added by the amendment.

Objection to the Specification

The Office states that the abstract of the disclosure should be amended to remove the

phrase “The present invention” (Office Action, p. 2). Applicants have amended the abstract as suggested by the Office. This objection can be withdrawn.

Rejection under 35 U.S.C. § 112, second paragraph

The Office rejects claims 1, 3-5, and 11, stating that “[t]he metes and bounds of Claim 12 [sic: Claim 1] are rendered uncertain by the phrase ‘wherein the composition increases the endogenous expression of lubricin by at least 10% relative to an untreated control’ because it is unclear as to what an ‘untreated control’ is” (Office Action, p. 3). Claim 1 has been amended to remove this phrase. This rejection can now be withdrawn.

Rejection under 35 U.S.C. § 103(a)

The Office rejects claims 1, 3-5, and 11 under 35 U.S.C. § 103(a) for obviousness over Laurent in view of Wadsworth, Watson, and Maurer. The Office states:

Laurent teaches a composition for treatment and prevention of bone disorders, wherein the bone disorder is osteoarthritis, wherein the composition comprises oats, which is synonymous with oat straw (*Avena sativa*), D-L-methionine and panthothenate (which is synonymous with vitamin B₅).

Laurent does not teach horsetail, oat straw powder or quercetin. However, Wadsworth teaches a composition comprising Noni, which contains methionine..., panthothenic acid (which is synonymous with vitamin B₅), horsetail herb..., oatmeal (which reads on oat straw powder,...and quercetin...[.] and wherein the composition can treat arthritis.(Office Action, pp. 4-5.)

The Office further states that “Watson teaches a food supplement comprising borage seed oil for improving joint flexibility” (Office Action, p. 5) and “Maurer teaches a composition for treating rheumatoid arthritis or polyarthritis comprising bromelain” (Office Action, p. 5).

Applicants respectfully disagree that the combination of Laurent, Wadsworth, Watson,

and Maurer renders claims 1, 3-5, and 11 obvious. Nonetheless, Applicants have amended independent claim 1 to recite that the composition “consists essentially of” two or more of the indicated substances and that it optionally includes one or more agents from the recited list. The MPEP states that “the transitional phrase ‘consisting essentially of’ limits the scope of the claim to the specified materials or steps ‘and those that do not materially affect the basic and novel characteristic(s)’ of the claimed invention” (MPEP § 2111.03). A material or step “has a material effect on the characteristics of the [claimed invention] ‘if the effect is of importance or of consequence to those of ordinary skill in the art...’” *PPG Industries v. Guardian Industries*, 156 F.3d 1351, 1354, 48 USPQ2d 1351, 1353-54 (Fed. Cir. 1998). Laurent, Wadsworth, Watson, and Maurer, either alone or in combination, fail to teach or suggest the composition of claims 1, 3-5, and 11, as presently amended, because each describes compositions having an ingredient that would materially affect the basic and novel characteristics of the composition of present claims 1, 3-5, and 11.

Laurent describes a composition that includes zeolite as the active ingredient, which is used to treat bone disorders, such as osteoarthritis, in animals (see, e.g., col. 6, lines 20-26). Zeolite acts by improving bone strength (see col. 6, lines 30-34). Zeolite would materially affect the basic and novel characteristics of the presently claimed compositions. Thus, the compositions of present independent claim 1, and claims dependent therefrom, exclude zeolite.

Wadsworth describes compositions that include noni, which is the Indian Mulberry plant (*Morinda citrifolia*). Wadsworth states that “noni has been known to provide a number of anecdotal effects for cancer, arthritis, headaches, indigestion, malignancies, broken bones, high

blood pressure, diabetes, pain, infection, asthma, toothache, blemishes, immune system failure, and others" (§ [0048]). Noni would materially affect the basic and novel characteristics of the compositions of present independent claim 1, and claims dependent therefrom. Thus, the compositions of independent claim 1, and claims dependent therefrom, as presently amended, exclude noni.

Watson describes "a food supplement formulation, comprising flaxseed oil, borage seed oil, fish oil, and lipase...[, that] may synergistically work together to improve bodily functions such as...joint flexibility" (col. 1, lines 34-39, and col. 2, lines 26-30). The combination of flaxseed oil, borage seed oil, fish oil, and lipase would materially affect the basic and novel characteristics of the compositions of present independent claim 1, and claims dependent therefrom. Thus, the composition of independent claim 1, and claims dependent therefrom, as presently amended, exclude the combination of flaxseed oil, borage seed oil, fish oil, and lipase.

Finally, Maurer describes the use of bromelain to reduce or prevent inflammation (see Abstract). Nowhere does Maurer teach or suggest the composition of present independent claim 1, and claims dependent therefrom.

For the reasons discussed above, none of the cited publications, when considered alone, teaches or suggests the composition of present claims 1, 3-5, and 11.

The combination of one or more of the cited publications would also fail to yield the composition of present claims 1, 3-5, and 11 because such a combination would result in a composition having one or more ingredients (i.e., zeolite, noni, or flaxseed oil, fish oil, and lipase) that materially affect the basic and novel characteristics of the composition of present claims 1, 3-5, and 11. One of ordinary skill in the art would recognize that the inclusion of any

of these ingredients would materially affect the basic and novel characteristics of the claimed invention. Thus, Applicants submit that the transitional phrase "consisting essentially of" excludes those ingredients from the composition of present claims 1, 3-5, and 11. As such, the invention of independent claim 1, and claims dependent therefrom, is not taught or suggested by Laurent, Watson, Wadsworth, and Maurer, either alone or in combination. For this reason, one of skill in the art would not combine the compositions described in Laurent, Watson, Wadsworth, and Maurer to achieve the composition of independent claim 1, and claims dependent therefrom, as presently amended.

Moreover, one of skill in the art would not prepare a composition that included any of the other ingredients described in the cited publications to the exclusion of the preferred ingredients (i.e., the zeolite of Laurent, the noni of Wadsworth, or the flaxseed oil, fish oil, and lipase of Watson) because Laurent, Wadsworth, and Watson state that it is the preferred ingredient(s) that provides the health benefits sought. Thus, one of skill in the art would not pick and choose from among the various ingredients described in Laurent, Wadsworth, Watson, and Maurer to the exclusion of the preferred ingredients to achieve the composition of present claims 1, 3-5, and 11.

For all of these reasons, the rejection of claims 1, 3-5, and 11 should be withdrawn.

CONCLUSION

Applicant submits that present claims 1, 3-5, and 11 are in condition for allowance, and such action is respectfully requested. Applicants also request rejoinder of claims 6-10, 12-17, and 20-56.


A petition to extend the period for replying for three months, to and including June 8, 2009, is submitted herewith. Applicant authorizes the Office to deduct the fee required by 37 C.F.R. § 1.17(a) for the petition from Deposit Account No. 03-2095.

If there are any other charges or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

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Date: 8 June 2009


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